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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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MARSHALL, GERSTEIN & BORUN LLP 6300 SEARS TOWER 233 S. WACKER DRIVE CHICAGO, IL 60606				
			EXAMINER COBURN, CORBETT B	
			ART UNIT 3714	PAPER NUMBER
DATE MAILED: 11/06/2003				

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/039,228

Applicant(s)

TESSMER ET AL.

Examiner

Corbett B. Coburn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-70 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 14, 16, 19, 24-41, 44, 46, 49 and 53-70 is/are rejected.
- 7) ☒ Claim(s) 12, 13, 15, 17, 18, 20-23, 42, 43, 45, 47, 48 and 50-52 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 24, 25, 30, 53, 54, 59 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are drawn to the perceived ability of a player or opponent. Perception is a mental process and is non-statutory.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 3, 5, 9, 10, 27-29, 31, 35, 39, 40, 56-58, 61, 65, 69 & 70 is rejected under 35 U.S.C. 102(e) as being anticipated by DeMar et al. (US Patent Number 6,315,660).

Claim 1, 31, 61: DeMar teaches a method of providing a bonus game. (Abstract)

DeMar teaches deferred-execution instructions or bonus resources. (Col 50, 35-39)

These are advantages. DeMar teaches that the bonus resources may be exercisable in response to player input. (Col 50, 48) This is receiving a selection of a first advantage from a player and providing the first advantage for a first play of the bonus game by the player. In order to function the gaming machine must have memory and programming.

Claim 3, 33, 63: DeMar teaches displaying a plurality of advantage choices for selection of the first advantage by the player. (Col 50, 51-54)

Claim 5, 35, 65: DeMar teaches receiving a selection of a second advantage from the player and providing the second advantage for the first play of the bonus game by the player – the player may have any number of bonus resources. (Col 50, 51-54)

Claim 9, 39, 69: DeMar teaches determining whether the player won a predetermined outcome from the first play of the bonus game. For instance, the player might land on a particular “property” or other square. (Col 50, 68 – Col 51, 22)

Claim 10, 40, 70: DeMar teaches that the player may use any number of bonus resources. (Col 50, 51-54) Thus if the player was determined to have won the predetermined outcome from the first play of the bonus game the player may receive a selection of a second advantage from the player providing the second advantage for a second play of the bonus game by the player.

Claim 27, 56: DeMar teaches bonus resources that override performance of an instruction otherwise indicated in the bonus game. For example, A “Get Out Of Jail Free” card will keep the game from ending when the player lands on a “Go to Jail” space. (Col 51, 1-22) This is an advantageous alteration of the environment for bonus game play for a player.

Claim 28, 57: Getting a “Get Out O Jail Free” card is acquisition of an article advantageous for a player in bonus game play.

Claim 29, 58: A “Get Out O Jail Free” extends the game beyond the time at which it should end. This is an advantageous time element for a player in bonus game play.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2, 4, 6-8, 26, 32, 34, 36-38, 55, 60, 62, 64 & 66-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeMar as applied to Claim 1, 3, 31, 33, 61 or 63 in view of Falciglia (US Patent Number 5,935,002).

Claim 2, 32, 62: DeMar teaches that bonus resources may be exercisable in response to player input (Col 50, 48), but does not teach prompting the user to effect the selection of the first advantage. The player must know when to provide this input in order to play the game. Falciglia teaches prompting the player to effect the selection of a first advantage (i.e., free spin). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified DeMar to prompt the player to effect the selection of the first advantage, as taught by Falciglia, in order to let the player know when to provide the input necessary to have a playable game.

Claim 4, 34, 64: DeMar teaches that the player may earn a number of bonus resources. (Col 50, 51-54) DeMar does not specifically teach displaying a total of available advantage credits to the player. Falciglia teaches displaying a number of free spins (Fig 10, 238). These free spins are equivalent to DeMar's bonus resources. Displaying the number of bonus resources provides information to the player. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified

DeMar to include the Falciglia's free spin meter to display a total of available advantage credits to the player in order to give information to the player.

Claims 6-8, 36-38, 66-68: DeMar teaches the invention substantially as claimed, but does not specifically teach requiring the player to pay for the first advantage. Falciglia teaches having a player buy a bonus advantage (i.e., a spin). (Fig 14, 344) This payment is in the form of credits earned in association with play of an associated primary game (Fig 14) or from money tendered (via coin slot 9). This increases the casino's revenue. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified DeMar in view of Falciglia to require the player to pay for the first advantage in order to increase casino revenues.

Claim 26, 55: DeMar teaches the invention substantially as claimed. DeMar teaches bonus resources that provide an advantage to the player possessing them. DeMar does not, however, teach competition between players. Falciglia teaches competition between players. (Fig 10 shows a list of the top 6 players in a multi-person game.) Competition between players encourages more people to play, thus generating greater profits. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified DeMar to allow players to compete as suggested by Falciglia in order to encourage more people to play, thus generating greater profits.

Claim 60: DeMar teaches the invention substantially as claimed, but does not teach the bonus game being remotely administered by a bonus event computer. Falciglia teaches a bonus event server (186). This allows players to compete against each other. Competition between players encourages more people to play, thus generating greater

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profits. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified DeMar to have the bonus game remotely administered by a bonus event computer as suggested by Falciglia in order allow competition between players that will encourage more people to play, thus generating greater profits.

6. Claims 11, 16, 19, 41, 46 & 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeMar as applied to claim 1 or 31 above, and further in view of Nicastro, Sr. (US 2003/0027619).

Claim 11, 41: DeMar teaches the invention substantially as claimed but does not teach that the bonus game is Pong. DeMar teaches a trail game – i.e., the token follows a path. Nicastro teaches a gaming machine in which the bonus game is either a trail game or a game of physical skill such as ping-pong. (0053, 0083, 0084 & Fig 20) Nicastro teaches that such games increase player participation, thus leading to higher profits. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified DeMar to include Pong as a bonus game as suggested by Nicastro in order to increase player participation, thus leading to higher profits.

Claim 16, 46: Nicastro teaches that basketball is equivalent to ping-pong. (0034)

Claim 19, 49: Nicastro teaches that the bonus game may be any target game. (0034)

Hockey is a target game.

7. Claims 14, 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeMar and Nicastro as applied to claim 11 or 44 above, and further in view of Runte et al. (US Patent Number 4,015,846).

Claim 14, 44: DeMar and Nicastro teach the invention substantially as claimed.

Nicastro teaches a ping-pong bonus game, but fails to give a detailed description.

Nicastro fails to teach the player's paddle shrinking during the ping-pong game. Runte teaches a ping-pong game in which the player's opponent's paddle may grow during the game. (Abstract) This is equivalent to the player's paddle shrinking relative to the opponent's paddle. This increases the challenge of the game, thus making the game more enjoyable. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the invention taught by DeMar and Nicastro to have the player's paddle shrink relative to the opponent's paddle as taught by Runte in order to increase the challenge of the game, thus making it more enjoyable.

Allowable Subject Matter

8. Claims 12, 13, 15, 17, 18, 20-23, 42, 43, 45, 47, 48, 50-52 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
9. The following is a statement of reasons for the indication of allowable subject matter:
 - a. Regarding Claims 12, 13, 15, 42, 43, 45 a thorough search of the prior art fails to disclose any reference or references, that, taken alone or in combination, teach or suggest, in combination with the other limitations, changing the size of player or opponent paddles.
 - b. Regarding Claim 17, 47, a thorough search of the prior art fails to disclose any reference or references, that, taken alone or in combination, teach or suggest, in

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combination with the other limitations, providing a longer set of legs for a basketball player.

c. Regarding Claim 18, 48, a thorough search of the prior art fails to disclose any reference or references, that, taken alone or in combination, teach or suggest, in combination with the other limitations, providing a smaller ball.

d. Regarding Claims 20, 21, 50, 51 a thorough search of the prior art fails to disclose any reference or references, that, taken alone or in combination, teach or suggest, in combination with the other limitations, changing the size of player or opponent stick.

e. Regarding Claims 22, 23, 52, a thorough search of the prior art fails to disclose any reference or references, that, taken alone or in combination, teach or suggest, in combination with the other limitations, changing the size of player or opponent goal.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (703) 305-3319. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.


cbc


JESSICA HARRISON
PRIMARY EXAMINER